

Appl. No. 10/755,427
Amendment dated July 10, 2009
Reply to Office Action Mailed April 10, 2009

REMARKS

The above-identified application has been reviewed in light of the Office Action mailed on April 10, 2009. By the present amendment, the Applicants have amended claims 1, 9, and 19-22. Additionally, the Applicants have added new claims 23-26 for consideration. It is respectfully submitted that the pending claims are fully supported by the specification, introduce no new matter, and are allowable over the references of record.

The Applicants would like to thank Examiner Yabut for the courtesies extended to the Applicants' representative, Dana A. Brussel, Esq., during the personal interview conducted on May 28, 2009. During the interview, Examiner Yabut and the Applicants' representative discussed the differences between the pending claims and one of the cited references. Examiner Yabut indicated that she would reconsider the pending claims in view of the cited references.

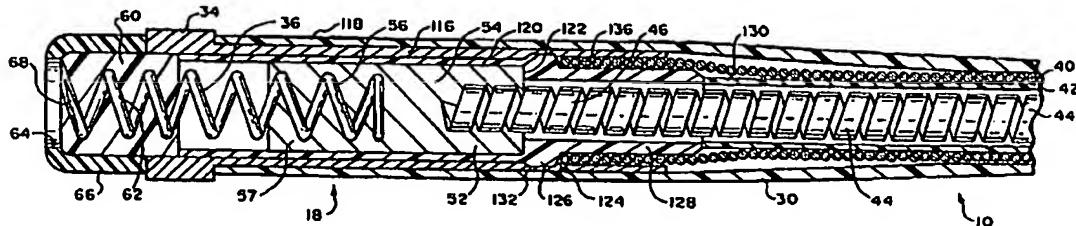
In the Office Action, claims 1, 4-6, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,628,943 to Miller ("Miller"). According to the Office Action, Miller discloses an applicator having a rotator that remains longitudinally or axially stationary with respect to the outer tube upon actuation of the actuator. The Applicants respectfully disagree and traverse the rejection for the reasons detailed below.

Claim 1 recites an applicator including, *inter alia*, an outer tube, an actuator, a fastener, and a rotator, wherein "actuation of the actuator rotates and translates the at least one fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube." Similarly, claim 19 recites an applicator having, *inter alia*, an outer tube, an actuator, a fastener, and a rotator, wherein "actuation of the actuator rotates and translates each fastener of the plurality of fasteners relative to the outer tube and the rotator remains axially stationary with respect to the outer tube."

However, Miller relates to a device for installing a cardiac electrode into body tissue.

Briefly, as illustrated below in Figure 2 of the Miller reference, a distal end 46 of a helical drive member 44 is mechanically connected to a proximal end 52 of a cylindrical mounting member 54 that is rotatably mounted within an electrode assembly 18. A proximal end 56 of a securing device 36 is mounted to a distal end 57 of the cylindrical mounting member 54. A plug 60 is disposed at a distal end of the electrode assembly 18. The plug 60 includes a spiral passageway 62 for receiving the securing device 36 therein. A space is defined between the distal end of the mounting member 54 and the proximal end of the plug 60.

FIG. 2



As configured, rotation of the helical drive member 44 causes rotation of the mounting member 54 and the securing device 36. Thus, "the securing device 36 is rotated through the passageway 62 in a screw like manner and exits the passageway 62 through an opening 64 in an insulative tip member 66." (Miller at Col. 6, ll. 15-18). Since the proximal end 56 of the securing device 36 is mounted to the distal end 57 of the mounting member 54, as the securing member 36 moves forward through the passageway 62 in a screw like manner, the forward movement of the securing device 36 acts to longitudinally/axially reposition the mounting member 54 distally through the space until it contacts the proximal end of the plug 60. Further still, Miller's device only includes a single securing device 36 and does not eject the securing device 36 from the distal electrode assembly 18. Rather, Miller's device is specifically

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configured such that the securing device 36 is retained within the distal electrode assembly 18 for forming the anode portion of the electrical circuit. As disclosed in Miller, the electrical circuit (i.e. conductive path) is formed when the securing device 36 is inserted into an atrium or ventricle of a heart after the lead 10 is implanted, which establishes the anode connection. Then a cathode connection is established from terminal pin 22 to ring electrode 34 with the anode connection being from anode ring 24 to securing device 36. (see Miller at Col. 7, ll. 62-68). Separating the securing device 36 from the pacing lead 10 would interrupt the electrical connection, thereby defeating Miller's intended purpose.

Thus, Miller fails to anticipate or suggest the applicator recited in claims 1 and 19. Further still, Miller's disclosure is directed away from the claimed subject matter since operation of Miller's device necessitates rotation and longitudinal translation of the mounting member 54, while maintaining a connection between the securing device 36 and the pacing lead 10. Therefore, it is respectfully submitted independent claims 1 and 19 are in condition for allowance. Since claims 4-6 depend from independent claim 1, it is respectfully submitted that these claims are also in condition for allowance.

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being obvious over Miller in view of U.S. Patent No. 4,596,350 to Smith et al. ("Smith"). According to the Office Action, Miller discloses the applicators recited in claims 2 and 3 except for a lock/clip indicator and a load spring. The Office Action stated that Smith discloses a lock/clip indicator for engaging a plurality of fasteners from the applicator and a load spring for applying longitudinal forces against the lock/clip indicator and that it would be obvious to provide Miller with the lock/clip indicator and load spring of Smith.

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As previously discussed, Miller does not disclose or suggest the applicator recited in claim 1. Adding the lock/clip indicator and load spring of Smith to Miller fails to cure the deficiencies of Miller. Smith fails to disclose or suggest any additional features that, in combination with Miller, suggest the applicator recited in claims 2 and 3. Since claims 2 and 3 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claims 7 and 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of U.S. Patent No. 5,100,420 to Green et al. ("Green"). According to the Office Action, Miller discloses the applicator recited in claim 8 except for a distal portion being disposable and the proximal portion being reusable. The Office Action asserted that Green discloses a distal portion being disposable and the proximal portion being reusable and that it would be obvious to provide Miller with the disposable distal portion and the reusable proximal portion of Green.

As discussed above, Miller does not disclose or suggest the applicator recited in claim 1. Adding the distal and proximal portions of Green fails to cure the deficiencies of Miller. Green fails to disclose or suggest any additional features that, in combination with Miller, suggest the applicator recited in claim 8. Since claim 8 depends from claim 1, it is respectfully submitted that this claim is in condition for allowance and the rejection of the Office Action has been overcome.

Claims 9-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of U.S. Patent No. 5,607,436 to Pratt et al. ("Pratt"). The Office Action asserted that Miller discloses the applicators recited in claims 9 and 14 except for a lever having a first end, a midsection, a second end, a lead screw, and a nut driver. The Office Action stated that Pratt discloses a lever having a first end, a midsection, a second end, a lead screw, and a nut driver and

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that it would be obvious to provide Miller with the lever, midsection, second end, lead screw, and nut driver of Pratt.

As discussed hereinabove, Miller does not disclose or suggest the applicator recited in claim 1. Adding the lever of Pratt fails to cure the deficiencies of Miller. Pratt fails to disclose or suggest any additional features that, in combination with Miller, suggest the applicator recited in claims 9-16. Since claims 9-16 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Pratt and further in view of U.S. Patent No. 5,487,500 to Knodel et al. (“Knodel”). The Office Action stated that Miller and Pratt disclose the applicator recited in claims 17 and 18 except for a plurality of teeth formed on the mid-section extension. The Office Action asserted that Knodel discloses a mid-section extension formed with a plurality of teeth and that it would be obvious to provide Miller and Pratt with the plurality of teeth of Knodel.

As previously discussed, Miller does not disclose or suggest the applicator recited in claim 1. Adding the mid-section extension of Knodel fails to cure the deficiencies of Miller and Pratt. Knodel fails to disclose or suggest any additional features that, in combination with Miller and Pratt, suggest the applicators recited in claims 17 and 18. Since claims 17 and 18 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

In the Applicants response filed on February 5, 2009, the Applicants added new claims 20-22. These added claims were not considered in the Office Action mailed on April 10, 2009. Each of claims 20-22 depends from claim 19. As discussed above, Miller, by itself or in combination with any of the cited references, does not disclose or suggest the applicator recited

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in claim 19. Since claims 20-22 depend from claim 19, the Applicants respectfully submit that claims 20-22 are not disclosed or suggested by Miller and are therefore in condition for allowance.

The Applicants have added new claims 23-26 for consideration. As noted above, none of the references either anticipates or suggests the applicant recited in claim 1. Since claims 23-26 depend from claim 1, it is respectfully submitted that they are in condition for allowance.

As part of the Applicants continuing duty of disclosure, the Applicants are informing the Examiner that U.S. Patent Application Serial Number 11/978,893, a related family application is presently docketed to Examiner Vi X. Nguyen in art unit 3734. Examiner Nguyen has not yet issued an Office Action in connection with this related family application.

In view of the foregoing, reconsideration of the application and allowance of claims 1-26 is earnestly solicited. Should the Examiner desire a telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5713.

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Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefore.

Respectfully submitted,

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